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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,201	04/27/2001	Louis S. Kucera	443-11U2	2151

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EXAMINER

OWENS JR, HOWARD V

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/844,201	KUCERA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Howard V Owens	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 9,24-27 and 36 is/are withdrawn from consideration.
- 5) Claim(s) 3-8,11-13,30-35 and 38-40 is/are allowed.
- 6) Claim(s) 1,2,10,28,29 and 37 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

### **Response to Restriction/Election**

Applicant's have elected Group I and Species 1 with traverse. Applicant's arguments filed 11/23/2004 have been fully considered but they are not persuasive with regards to whether a restriction/species election is warranted; however, the examiner will include Group II with Group I for the purposes of examination.

Applicant argues that a reasonable number of species is set forth; however, the key factor for supporting a species requirement is whether the species are unpatentable over one another:

### MPEP 808.01

Election of species should not be required if the species claimed are considered clearly unpatentable (obvious) over each other. In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

One of skill in the art would clearly recognize that agents and methods associated with the treatment of cancer are patentable over the treatment of a virus. Moreover, applicant has not demonstrated that the number of compounds represented by antiviral

agent and nucleoside analogue as set forth in Species 1 are reasonable. A search would be required for thousands of compounds which fit the description of a nucleoside analogue or an antiviral agent as set forth in Species 1 and clearly constitutes a burdensome search.

The requirement is still deemed proper and is therefore made FINAL.

An action on the merits of claims 1-8 and 10 – 23, 28-35 and 37-40 is set forth below.

**Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 10, 28, 29 and 37 are rejected under 35 U.S.C. § 102(b) as being anticipated by Surles , American Oil Chemists Society, Vol. 28(1), pp. 55-57, 1993 (see pp. 55 and 56) or Meyer, J. Med. Chem. Vol. 34, pp. 1377-1383, 1991 (see Fig. 3); or Hong et al., J. Med. Chem., Vol. 33, pp. 1380-86, 1990.

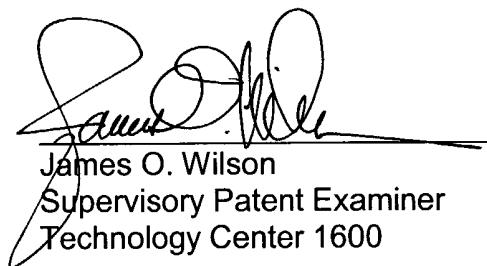
Claims 1, 2, 10, 28 and 37 are drawn to phosphoglyceride compounds, compositions and methods of treating viruses of Formula III. Formula III is anticipated by Surles , American Oil Chemists Society, Vol. 28(1), pp. 55-57, 1993 (see pp. 55 and 56); Meyer, J. Med. Chem. Vol. 34, pp. 1377-1383, 1991 (see Fig. 3) or Hong et al., p. 1381, with substitution of the following variables:

X<sup>11</sup>=O; R<sup>11</sup>=C<sub>1</sub>-C<sub>16</sub> alkyl; X<sup>12</sup>= O; R<sup>12</sup> and R<sup>12'</sup> = C<sub>1</sub>-C<sub>16</sub> alkyl; R<sup>13</sup>= N(R<sup>6</sup>)(R<sup>7</sup>)(R<sup>8</sup>) or a therapeutic agent (see Hong substitution of anti-tumor cytidine conjugate, Fig. 9b,c).

**Allowable Subject Matter**

Claims 3-8, 11-13 and 30-35 and 38-40 containing AZT substituted at the C2 of the phosphoglyceride compound appear to contain compounds/compositions allowable over the closest prior art of record, Surles , American Oil Chemists Society, Vol. 28(1), pp. 55-57, 1993 or Meyer, J. Med. Chem. Vol. 34, pp. 1377-1383, 1991.

Howard V. Owens  
Patent Examiner  
Art Unit 1623



James O. Wilson  
Supervisory Patent Examiner  
Technology Center 1600

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (571) 272-0658 . The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (571) 272-0661.